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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,305	04/08/2004	William Andrew Wilson	P06296US02 - PHI 1443	7443

27142 7590 02/17/2006

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EXAMINER

IBRAHIM, MEDINA AHMED

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/820,305	WILSON ET AL.	
	Examiner	Art Unit	
	Medina A. Ibrahim	1638	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 03 February 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 13 and 14.
Claim(s) objected to: _____.
Claim(s) rejected: 1-12 and 15-34.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

Continuation of 11. does NOT place the application in condition for allowance because: arguments regarding the written description rejection are duplicatives of that have been previously addressed and which are not persuasive. Applicant asserts that the phrase "Unauthorized seed multiplication prohibited. U.S. Protected Variety" is from the statutory language at 7 USC 2567 and does not introduce a new matter. The Examiner, however, notes that the statutory at 7 USC 2567 itself has no basis in the specification (page 62).

Continuation of 13. Other: Applicant's arguments regarding the 112, 2nd rejection as being indefinite and the written description rejection are not persuasive for the reasons of record. Applicant reiterates that SSR profile of Table 4 is an identifying characteristics that describes the genus of hybrids of PH8CW. Applicant cites Ex Parte C, 1992 WL (B.P.I. 1992) and Enzo Biochem. Inc., (323 F3d at 965, 63 U.S.P.Q. 2d at 1613(2002) to support this position. These are not persuasive because the SSR profile of Table 4 describes the PH8CW inbred and not the hybrid produced from the inbred using with any other different inbred maize line. While the hybrids will inherit the SSR marker profile of PH8CW, they will not inherit the same genetic markers from the other parents (non-PH8CW parents involved in the breeding) because they have different parents having different markers. The SSR marker profiles of other parents are not described. In addition, the specification does not describe the traits that are associated with the SSR loci of Table 4. The SSR are named, but the written descriptions of the sequence of each of the SSR markers are not provided. Without description of the sequences of the SSR markers, one cannot confirm the presence of the same SSR markers in any plant.

The claims considered in Ex parte C (1992) didn't involve F1 hybrid where one of the parents involved in the breeding was unknown. Self-pollinating the soybean plant from the deposited seed produced the first generation seed of the claims in Ex parte C. In the instant application, hybrid plants and seed of the claims are produced by crossing plants of the inbred maize PH8CW with any distinct unknown inbred maize line. Hybrids that do not share both of the same parents will not have the same traits and the fact that they share one set of chromosomes from PH8CW does not provide any description for the hybrids.

And unlike in Enzo Biochem, Inc (2002), here the deposited seed of inbred PH8CW does not correspond exactly to the claimed seed or plant comprising at least one set of the chromosomes of inbred PH8CW, including F1 hybrid seed/plant, as stated in the last Office action. The function of the plant grown from PH8CW seed is correlated with the structure of its entire genome. The functions of the claimed hybrid plants grown from the claimed hybrid seeds are correlated with the structures of their entire genomes, not just the set of chromosomes inherited from PH8CW. Applicant has provided no evidence to support the conclusion that the function of the claimed hybrid correlated to the set of chromosomes originating from the deposited PH8CW, as stated in the last Office action. Therefore, the decisions in Enzo Biochem, Inc (2002) and in Ex parte C (1992) do not support Applicant's position. .

The cited articles by Openshaw ; Ragot et al; and Smith et al regarding the use of molecular markers in maize breeding have been considered but are not deemed persuasive. Ragot et al, for example, state "...production of fully converted isogenic lines through classical backcrossing procedure in a lengthy procedure, if at all possible. Theoretically, a minimum of seven classical backcross generations are required to recover more than 99% of recurrent parent genotype, assuming no linkage drag". These statements do not appear to support Applicant's position. In addition, Applicant has not disclosed a single example of marker assisted backcrossing or use of SSR to identify a progeny of the exemplified inbred. Therefore, for the reasons discussed above and in the last Office actions the claims lack adequate written description.

MEDINA A. IBRAHIM
PATENT EXAMINER

Medina A. Ibrahim